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10/594,147	09/25/2006	Satoshi Kondo	2006_1398A	7777
52349 7590 05/06/2011 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
PHILIPPE, GIMS S				
ART UNIT		PAPER NUMBER		
2485				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/594,147

Applicant(s)

KONDO ET AL.

Examiner

Gims S. Philippe

Art Unit

2485

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-912)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :09/25/06, 12/20/06, 03/24/08, 03/27/08, 04/02/09, 03/09/09, 10/25/10

DETAILED ACTION

1. This is a first office action in response to application no. 10/594,147 filed on September 25, 2006 in which claims 1-55 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005 <<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>>), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

3. Claim 46 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 46 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" - Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4 and 45-47 rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US Patent no. 7,139,014).

As per claims 1 and 45-47, Kim discloses a control method, integrated circuit and mobile terminal device comprising a broadcast reception unit operable to receive a television signal broadcast (See Kim col. 2, lines 59-65 and col. 3, lines 31-35), a display unit operable to display video (See col. 2, lines 65-67), an audio reproduction unit operable to reproduce audio (See col. 5, lines 53-62), and a control unit operable, when an event occurs while the received television broadcast is being outputted by the display unit and the audio reproduction unit, to control at least one of a displaying of video of the television broadcast by the display unit, a reproduction of audio of the television broadcast by the audio reproduction unit, and the event (See col. 6, lines 4-19).

As per claim 2, Kim further discloses a transmission/reception unit operable to transmit and receive an email, wherein the event is a reception of the email, and the control unit is operable, when the email is received to control the displaying of the video, the reproduction of the audio, and a processing of the email (See col. 11, lines 33-42).

As per claim 3, Kim further discloses a storage unit operable to record the received television broadcast, and a recording control unit operable to control the recording of the television broadcast into the storage unit, wherein the email is received, the control unit is operable to instruct the recording control unit to record the television broadcast and to have the display unit display the email (See Kim fig. 4, server 406, fig. 5, items 516 and col. 11, lines 61-67 and col. 12, lines 11-21).

As per claim 4, Kim further discloses a mobile terminal wherein after having the display unit display the e-mail, the control unit is operable to have the audio reproduction unit reproduce the audio of the received television broadcast (See Kim col. 12, lines 49-59). The applicant should note that the voicemail or audio message is an inherent feature in Kim's phone as the playback is performed when listening to the recoded message as suggested in Kim col. 1, lines 19-23.

6. Claims 1-4, 38-42 and 45-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe (US Patent Application Publication no. 2005/0070327 A1).

As per claims 1, 45-47, Watanabe discloses in figs. 1A and 1B a control method, integrated circuit and mobile terminal device comprising a broadcast reception unit operable to receive a television signal broadcast (See fig. 1A, item 1), a display unit operable to display video (See fig. 1A, item 13), an audio reproduction unit operable to reproduce audio (See fig. 1A, item 12, and paragraphs [0033-0035]), and a control unit

operable, when an event occurs while the received television broadcast is being outputted by the display unit and the audio reproduction unit, to control at least one of a displaying of video of the television broadcast by the display unit, a reproduction of audio of the television broadcast by the audio reproduction unit, and the event (See fig. 1A, items 143 and 145 and paragraphs [0039] and [0058-0061]).

As per claim 2, Watanabe further discloses a transmission/reception unit operable to transmit and receive an email, wherein the event is a reception of the email, and the control unit is operable, when the email is received to control the displaying of the video, the reproduction of the audio, and a processing of the email (See fig. 2, control unit 22, paragraphs [0039, 0061 and 0065]).

As per claim 3, Watanabe further discloses a storage unit operable to record the received television broadcast, and a recording control unit operable to control the recording of the television broadcast into the storage unit, wherein the email is received, the control unit is operable to instruct the recording control unit to record the television broadcast and to have the display unit display the email (See Watanabe paragraphs [0037, 0097-0098]).

As per claim 4, Watanabe further discloses a mobile terminal wherein after having the display unit display the e-mail, the control unit is operable to have the audio

reproduction unit reproduce the audio of the received television broadcast (See Watanabe paragraphs [0037, 0039 and 0097]).

As per claims 38-42, most of the limitations of these claims have been noted in the above rejection of claims 1. In addition, Watanabe further provide receiving a notification from display (0036-0037), television broadcasting, stop display of the broadcast (See 0038-0041), and to notify the user of an elapse time (See

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-37 and 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US Patent Application Publication no. 2005/0070327 A1).

Regarding claims 5-10, 12-14 and 48-55, most of the limitations of these claims have been noted in the above rejection of claims 1-4 and 45-47.

It is noted that while Watanabe discloses a control method, integrated circuit and mobile terminal device wherein an operation unit receives an operation from a user to

display an e-mail (See Watanabe paragraphs [0037 and 0039]), it is silent about the specific controls steps as detailed in the claims.

However, because Watanabe clearly provides a portable phone which provides the following features:

- a) the means to display e-mail attached to a photograph (paragraph 0036);
- b) an key input section 14 for various functions such as email key, address key, function keys (paragraph 0037);
- c) instructions for reproductions and temporary suspension when a mail is created;
- d) a control section judging whether or not to a TV switch is "on" or "off" (paragraph 0064);

Therefore, it is considered obvious that one skilled in the art at the time of the invention having the teachings of Watanabe as shown from a) to d) above, and detailed in paragraphs (0036-0041 and 90060-0064), would recognize the advantage of modifying Watanabe to provide steps such as "inquiring whether or not to display email before giving recording instructions" or "controlling the processing of the television". The motivation for performing such a modification in Watanabe is to solve the problem where the cell phone cannot receive television broadcasting once the same phone is in use as taught by Watanabe (See Watanabe paragraphs 0008-0009).

As per claim 15-20, most of the limitations of these claims have been noted in the above rejection of claims 1 and 17. In addition, Watanabe further discloses transmitting and receiving phone call, controlling the display, controlling the processing of the television

and the processing of the phone call, and recording the television broadcast, and an answering machine to answer an incoming phone call (See Watanabe paragraphs [0010-0011], [0039] and [0097]).

As per claims 21-25, most of the limitations of these claims are represented in the flowcharts shown in figs. 9-11 which are well known features of cellular phones in addition to the displaying of the television signal received on display 13 (fig. 9, item 908).

As per claims 11 and 26-27, most of the limitations of these claims have been noted in the above rejection of claim 17. In addition, Watanabe further discloses the split screen in fig. 13 and paragraph [0109].

As per claims 28-37, most of the limitations of these claims have been noted in the above rejection of claim 1. In addition, the features of detecting that the first main body unit and the second main body overlap each other while detecting the overlapping, instructing the user that the television has been recorded (See paragraphs [0072], [0111-0114]).

9. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US Patent Application Publication no. 2005/0070327 A1) in view of Cortegiano (US Patent no. 7,251,476).

Regarding claims 43-44, most of the limitations of these claims have been noted in the above rejection of claim 1.

It is noted that while Watanabe resumes displaying video or reproduction of the audio (See Watanabe 0039 and 0097), is silent about detecting end of commercials or the reproduction of the audio as specified in the claims.

However, Cortegiano provides a mobile terminal device including the feature of detecting end of commercials or the reproduction of the audio (See Cortegiano fig. 4, item 307 to 313 and col. 6, lines 47-67).

Therefore, it is considered obvious that one skilled in the art at the time of the invention would recognize the advantage of modifying Watanabe's displaying method by incorporating Cortegiano's feature of detecting end of commercials in the mobile terminal device. The motivation for performing such a modification in Watanabe is to offset cost to the end user by applying monetary value to an advertiser of advertising messages displayed in order to reduce the balance of the user account as taught by Cortegiano (See Cortegiano col. 3, lines 51-65).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okamura (US Patent no. 7,254,415) teaches portable wireless terminal method of outputting sound, and method of picking up sound.

Yunoki (US Patent no. 7,495,686) teaches portable cellular phone having capability of receiving TV broadcast record setting system and method for same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (10:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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